Claim 6 is amended to render it dependent on claim 1.

Claims 9 and 11 are amended to refer to the construct as a "cap gene" and to more definitively state the minimal AAV sequence(s) within the rep gene. This amendment finds support in the specification, for example, on page 10, lines 4-24.

New claims 21-24 are supported in the specification, for example, on page 5, line 37 and on page 2, lines 8-9 and also in original claim 2.

New claim 25 is supported in the specification, for example, on page 6, line 29 and page 9, lines 18-25.

New claims 26 and 27 are supported in the specification, for example, on page 4, line 36, through page 5, line 3.

New claims 28-30 are supported in the specification, for example, on page 7, lines 9-28, page 8, lines 14-15 and 33-36, and Example 4.

No new matter is added by way of these claim amendments. Moreover, as they serve to merely clarify the invention recited in the originally-filed claims, these amendments are not entered for purposes of patentability. For the convenience of the Examiner, the text of all claims pending upon entry of this amendment is attached to this Response, as is the text of the amended claims, marked so as to indicate the linguistic changes made by these amendments.

Discussion of claim rejections and objection

The Office Action objects to claim 1 for first use of the acronym "HSV" without reciting the antecedent. Claim 1 is also rejected under 35 US.C. § 112, second paragraph, for use of the term "first...gene" and because the requirements of the recited rep gene was allegedly unclear in the claim as originally filed. Claim 2 also is rejected under § 112, second paragraph, because the term "derived from" is allegedly vague.

Applicants respectfully urge that the language of the claims as originally filed was sufficiently clear to one of ordinary skill in the art, especially after reading the specification. Accordingly, applicants believe that the rejection was improper and that the claims as originally filed were in allowable condition. However, to advance prosecution, applicants have amended the claims as suggested in the Office Action.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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Date: February 25, 2002

CERTIFICATE OF MAILING

I hereby certify that this RESPONSE TO OFFICE ACTION (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231.

Date: Feb. 25, 2002 Peter Phillips

PATENT
Attorney Docket No. 204001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Glorioso et al.

Application No. 09/506,301

Art Unit: 1636

Examiner: G. Leffers, Jr.

Filed: February 17, 2000

For: ADENO-ASSOCIATED VIRAL GENE-TRANSFER VECTOR SYSTEM

AMENDMENTS TO CLAIMS
MADE IN RESPONSE TO OFFICE ACTION DATED NOVEMBER 23, 2002

Amendments to existing claims:

1. (Amended) A recombinant herpes simplex virus (HSV) [~~HSV~~] comprising a rep gene, which comprises a promoter operatively linked to a polynucleotide encoding an [~~first~~] adeno-associated virus (AAV) [~~gene comprising a promoter and a polynucleotide sequence encoding a~~] rep polypeptide, wherein the rep polypeptide or the promoter is conditionally active.

2. (Amended) The recombinant HSV of claim 1, wherein the rep polypeptide is obtained [~~derived~~] from an AAV rep78, rep68, rep62, or rep40 protein.

6. (Amended) The recombinant HSV of claim 1 [~~6~~], wherein the promoter is an inducible promoter.

8. (Amended) The recombinant HSV of claim 7, wherein the rep [~~first AAV~~] gene is not within the ITR cassette.

9. (Amended) The recombinant HSV of claim 1, further comprising a cap [~~second AAV~~] gene comprising a promoter operatively linked to [~~and~~] a polynucleotide sequence encoding an AAV [~~a~~] cap polypeptide.

11. (Amended) The recombinant HSV of claim 10, wherein the cap [~~first AAV~~] gene is not within the AAV ITR cassette.

New Claims:

21. The recombinant HSV of claim 1, wherein the rep polypeptide is an AAV rep78 protein.

22. The recombinant HSV of claim 1, wherein the rep polypeptide is an AAV rep68 protein.

23. The recombinant HSV of claim 1, wherein the rep polypeptide is an AAV rep62 protein.

24. The recombinant HSV of claim 1, wherein the rep polypeptide is an AAV rep40 protein.

25. The recombinant HSV of claim 1, wherein the promoter is a tissue specific promoter.

26. The recombinant HSV of claim 1, wherein the promoter is an HSV promoter

27. The recombinant HSV of claim 1, which is replication incompetent in cells other than packaging cells.

28. The composition of claim 16, which further comprises an ITR cassette.

29. The composition of claim 28, wherein the ITR cassette is within an HSV vector.

30. The composition of claim 16, further comprising a second HSV that comprises an ITR cassette.